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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	P02087US1	6074

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EXAMINER

ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 09/10/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/740,679

Applicant(s)

CUMMING, J. STUART

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/2/03 & 6/19/03.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 53-105 is/are pending in the application.
- 4a) Of the above claim(s) 58,60,62,64-72,75-89,91-98,100 and 101 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-57,59,61,63,73,74,90,99 and 102-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION***Election/Restrictions*

Applicant's addition of new claims 99-105 have been acknowledged. Applicant believes claim 77, which has been withdrawn from further consideration because of the reasons set forth in paper no. 10 (action mailed on 1/29/03), reads on the elected species because the stalk-like knobs 118 "clearly" have a thickness greater than the haptic inner end and because they are shown and described as "stalk-like knobs". It is noted, that because the element 118 is described as "stalk-like knobs", it does not mean that element 118 has inherently a thickness greater than the haptic inner end. Moreover, from the Figure 18, one can not "clearly", as stated by applicant, appreciate if the round area of element 118 has a thickness greater than the haptic inner end. Thus, it is the examiner's position that claim 77 does not read on the elected species of Figure 18. It is noted that new claims 100 and 101 depend from claim 77.

The status of the claims is the following:

Claims 58, 60, 62, 64-72, 75-89, 91-98, 100, and 101 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No.8.

Currently, claims 53, 90, and 105 are generic claims.

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### ***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on June 2, 2003 have been approved.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 53-57, 59, 61, 63, 73, 74, 90, 99, and 102-105 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,197,059, over claims 1-8 of U.S. Patent No. 5,476,514, and over claims 1-42 of U.S. Patent No. 5,674,282. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patents '059, '514, and '282 lies in the fact that the patent claims includes more elements and are more specific. Thus, the invention of the patent claims are in effect a "species" of the "generic" invention of the claims of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

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Since the claims of the application are anticipated by the claims of the patents '059, '514, and '282, they are not patentably distinct from the claims of the patents.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53-57, 59, 61, 63, 73, 74, 90, and 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Tennant (Reference U.S. Pat. 4,254,509 on PTO-1449).

Tennant discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, 90, and 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlegel (Reference U.S. Pat. 4,424,597 on PTO-1449).

Schlegel discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, 90, 99, 102, and 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlegel (Reference U.S. Pat. 4,673,406 on PTO-1449).

Schlegel discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the

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optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic. The bulge and/or notches 16 are considered the fixation means.

Claims 53-57, 59, 61, 63, 73, 74, 90, and 105 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kalb (Reference U.S. Pat. 4,585,457 on PTO-1449)

Kalb discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic having an optic axis, and a plurality of extended portions extending generally radially out from the optic. Each of extended portions having inner ends joined to opposite sides of the optics and opposite outer ends. The extended portions are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, 90, 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Portnoy (Reference U.S. Pat. 4,759,761 on PTO-1449).

Portnoy discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic having an optic axis, and a plurality of extended portions extending generally radially out from the optic. Each of extended portions having inner ends joined to opposite sides of the optics and opposite outer ends. The extended portions are movable anteriorly and posteriorly relative to the optic. It is noted that one of optics embodiment of Portnoy has the posterior surface convexly curved to a substantially steeper convex curvature than the anterior surface (see Figure 2b).

### ***Response to Arguments***

Applicant's arguments filed on June 2, 2003 have been fully considered but they are not persuasive.

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In response to applicant's argument that none of the references used are "adapted to be implanted within a natural capsular bag attached to a ciliary muscle of a human eye" or have a lens body "adapted to be disposed in the natural capsular bag of the eye and which body is operable to move ....." and that they are not "accommodating lens", it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In the instant case, the reference used discloses a lens that has the ability or capability to perform the function, is one so desired. Furthermore, beside that it is functional language, the recitation "accommodating", in the preamble, has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

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*Allowable Subject Matter*

Claims 103 and 104 would be allowable if a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) is filed to overcome the double patent rejection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

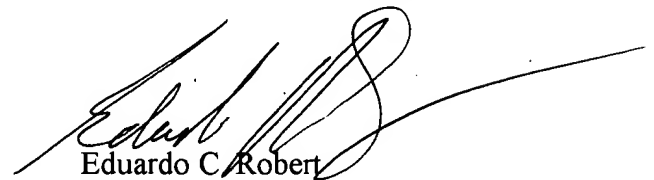
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C. Robert